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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,799	10/31/2003	Jeffrey R. Powers	056409-5095	1151

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EXAMINER

OMGBA, ESSAMA

ART UNIT PAPER NUMBER

3726

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/697,799

Applicant(s)

POWERS ET AL.

Examiner

Essama Omgba

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/7/04</u> . | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Claim Objections***

1. Claim 6 is objected to because of the following informalities: in line 2, "portion" should read --member-- in order to use consistent language through out the specification and the claims. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language of claim 5 is confusing as it is the examiner's understanding that frictionally engaging the resilient member to the nosepiece will aid in retaining the resilient member thereto because of the frictional forces. It is not clear how frictionally engaging the resilient member to the nosepiece will make it possible to retain the fixing on the nosepiece by frictional forces. Applicant is requested to please clarify.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5, 7, 8, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Lipsky et al. (US Patent 6,820,789).

With regards to claim 1, Lipsky et al. discloses a fixing assembly comprising a fixing (washer) and a disc-shaped (annular part 15) deformable piece 6 secured to the fixing (col. 2, lines 14-21) and being adapted for engaging a fastener exit of a fastener-driving tool (col. 1, lines 43-46).

For claims 2 and 3, see figure 3 wherein the height of disc-shaped part 15 is less than its width and the disc-shaped part includes a substantially flat upper surface.

With regards to claim 4, Lipsky et al. discloses a method of attaching a fixing (washer) to a workpiece using a fastener-driving tool from a nosepiece of the fastener-driving tool wherein a resilient member 6 secured to a nosepiece of the tool and a washer is provided in the resilient member and the washer is subsequently secured to the workpiece, see column 1, lines 43-46, column 2, lines 66-67 and column 3, lines 1-3 and 38-43. Applicant should note that the fastener-driving tool of Lipsky et al. is of the type that can be accommodated with a magazine containing fasteners discharged from a firing chamber.

For claim 5, see column 1, lines 59-61.

For claim 7, Applicant should note that a washer inherently includes an aperture.

With regards to claims 8 and 12, Lipsky et al. discloses a fixing assembly comprising a fixing (washer) adapted to be mounted to a workpiece and a resilient member 6 having a first portion 15 secured to the fixing and a second portion 9 adapted for frictional engagement with a fastener ejection portion of a fastener-driving tool, the resilient member having a width and a height wherein the ratio of the height to the width is less than unity, see column 1, lines 43-46, column 2, lines 14-21 and figures 3 and 4. For claim 11, Applicant should note that a washer inherently includes an aperture.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lipsky et al.

With regards to claim 6, Lipsky et al. discloses a method of attaching a fixing to a workpiece as shown above with the resilient member engaging with an outer wall of the nosepiece and not its inner wall. However it would have been obvious to one of ordinary skill in the art at the time the invention was made that having the resilient member engage with an inner wall of the nosepiece versus its outer wall is an obvious matter of design choice wherein no stated problem is solved or unexpected results obtained in engaging the resilient member with an inner wall of the nosepiece versus the outer of

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the nosepiece as taught by Lipsky et al., as long as a secured frictional connection is achieved between the nosepiece and the resilient member.

With regards to claims 9 and 10, Lipsky et al. discloses a method of attaching a fixing to a workpiece as shown above except for the second portion approximating a disc with a diameter greater than an entrance diameter of the fastener-ejection portion. However it would have been obvious to one of ordinary skill in the art at the time the invention was made that having the second portion of the resilient member approximate a disc with a diameter greater than an entrance diameter of the fastener-ejection portion is an obvious matter of design choice wherein no stated problem is solved in having the second portion of the resilient member approximate a disc with a diameter greater than an entrance diameter of the fastener-ejection portion versus the second portion as taught by Lipsky et al. as long as a secured frictional connection is achieved between the nosepiece and the resilient member.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (571) 272-4532. The examiner can normally be reached on M-F (10-7:30) First Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Essama Omgba  
Primary Examiner  
Art Unit 3726

eo  
April 5, 2005